Remarks

Claims 1-11 & 13-20 are at issue. Claims 1-11, 14, 16 & 18-20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Pepe et al in view of "Import Personal Address Book (PAB) to Outlook 97" by grant Miller. Claims 15 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al, Miller and further in view of Gunluk.

The applicant contacted the Examiner's supervisor and was asked to file an after final response and follow the response up with a telephone call to the Examiner and his supervisor.

The Examiner has made a number of legal errors:

1) The Examiner has assumed whole portions of his rejection instead of pointing to the prior art to support his position. The CAFC has been very clear that Official Notice and related assumptions may not be used in place of finding prior art when the applicant has traversed the rejections. (See In re Zurko, CAFC, August 2001, Case No. 96-1258b)

2. The Examiner continues to cite Microsoft publications Q162203 & Q169709 that are not prior art.

3. The Examiner has confused a database with a database program.

The applicant respectfully requests a withdrawal of the final rejection because of the above referenced legal errors.

The use of Official Notice or "inherently containing" is not allowed under the law. In In re Zurko, CAFC, August 2001, Case No. 96-1258b, the CAFC stated that the board's "assessment of basic knowledge and common sense was not based on any evidence in the record" and "the board cannot simply reach conclusions based on its own understanding or experience but must point to some concrete evidence." The applicant found the following key phrases in the rejection: "inherently", "obvious to add", "Official Notice", "Would inherently contain", "Inherently comprising a step", "It is assumed", "Inherently storing said addresses", "inherently using a program", "inherently comprising the step of selecting", "It is assumed that the data may comprise".

It is apparent that the Examiner does not have some concrete evidence to support his rejections. The applicant deserves a more through response.

In addition to these errors there is no suggestion in either Miller of Pepe et al to combine these references or to combine them in the manner suggested by the Examiner.

The continued use of Microsoft publications that are not prior art is clear legal error.

In claim 1 and elsewhere the Examiner has confused a database program such as Microsoft Access and the databases created with the program, for instance a list of personal addresses. The prior art cited by the Examiner clearly states that a "personal address book" choice will be found in your main address book. The "personal address book" is a database. The main address book is a folder for holding databases. In fact Microsoft publication Q169709 clearly states "there is no method for merging one Personal Address Book file with another." (See Notes) Thus it is clear that Miller is talking about creating new database not placing names in an existing database. As clearly required by claim 1.

While other points of contention exist it is impossible to resolve them without some basic agreement on the three points listed above. As a result, the applicant has chosen not to point out every detail where elements are not shown in the prior art. These points can be found in early responses.

At the least the applicant is entitled to a withdrawal of the final rejection and a new rejection that explains exactly where in the prior art the Examiner is finding the elements in the applicant's claims.

Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

(Hiatt, Jr.)

By Dale B. Halling

Attorney for the Applicant
Dale B. Halling
Phone: (719) 447-1990
Fax: (719) 447-0983

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Dale B. Halling
Signature(Dale B. Halling)

Law Offices of Dale B. Halling, L.L.C.
Registered Patent Attorney
24 South Weber, Suite 311
Colorado Springs, CO 80903
(719) 447-1990
FAX: (719) 447-9815

DATE: April 11, 2002

Official

FAX # 703-872-9314

TO: Charles Craver
(Addressee's Name) (Phone #)

FROM: Dale B. Halling 719-447-1990
(Senders Name) (Phone #)

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